

filed June 22, 2007 ("6/22/07 Submission"). The prior Declaration was unsigned as noted at page 2 of the 6/22/07 Submission. Other than the executed AUDOUSSET Declaration, the Remarks section of this Supplemental Submission and Response is identical to the 6/22/07 Submission, but is repeated below for the Examiner's convenience.

REMARKS

I. Status of the Claims

Claims 1-24, 43-47, 56, 57, and 60-102 are pending. Claims 5-7, 11-13, and 16-22 are objected to and claims 1-4, 8-10, 14, 15, 23-24, 43-47, 56, 57, and 60-102 stand rejected.

Applicants respectfully acknowledge the Office's indication that claims 5-7, 11-13, and 16-22 would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claims. However, Applicants choose not to rewrite the allowable claims in independent form at this time.

II. Rejections under 35 U.S.C. § 103(a)

A. Claims 1-3, 25-44, and 60-102 in view of Cottard

The Office maintains the rejection of claims 1-3, 25-44, and 60-102 under 35 U.S.C. § 103(a) for allegedly "being unpatentable over" U.S. Patent Application Publication No. 2001/0023515 A1 to Cottard et al. ("Cottard") for the reasons set forth in the Office Action dated October 28, 2005 and the additional reasons set forth on pages 2-4 of the Final Office Action. Applicants respectfully disagree and continue to traverse the rejection for reasons of record and the following additional reasons.

In the Final Office Action, the Office repeats the assertion of record that the presently claimed weight ratio between the at least one aminosilicone and the at least one associative polymer would have been obvious. See Final Office Action at pages 2-4. Specifically, the Office alleges that Cottard teaches a dyeing composition comprising oxidation dyes, cationic thickening polymers as claimed, in the amount of 0.01 to 10%, and "effective quantities of other agents . . . known for oxidation coloring and organomodified silicones are among these agents." *Id.* at page 3. The Office concludes on this basis only that "there is a clear suggestion and sufficient motivation to one having ordinary skill in the art to be motivated to optimize the weight ratio of the aminosilicone to the cationic associative polymers to arrive at the present invention." *Id.*

Applicants continue to traverse this rejection because the Office has failed to establish, as required by M.P.E.P. § 2143, a prima facie showing of obviousness. Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or nonobviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. 467.

Thus, in order to carry the initial burden of establishing a prima facie case of obviousness that satisfies the *Graham* standard, the Examiner must at least show that the prior art reference must teach or suggest all the claim limitations, and that there is

some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. *See* M.P.E.P. § 2143. The Supreme Court, in the recent *KSR Int'l Co. v. Teleflex, Inc.* case, recognized that a showing of “teaching, suggestion, or motivation” could provide helpful insight in determining whether the claimed subject matter is obvious under Section 103(a). *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 U.S.P.Q.2d 1385, 1396 (2007).

In addition, the Supreme Court mandates that “[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit.” *Id.* at 1741, 82 U.S.P.Q.2d at 1396 (citing *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)).

Following the *KSR* decision, the U.S. Patent and Trademark Office issued a memorandum to its technology center directors on May 3, 2007, indicating that “**in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.**” (Emphasis in original).

Despite its assertions to the contrary, in the present case, the Office has neither established that the prior art references teach or suggest all the claim limitations nor that there is some suggestion or motivation, either in the references or in the knowledge

generally available to one of ordinary skill in the art, to modify or combine the references. In particular, the position of the Office that the presently claimed aminosilicone/associative polymer weight ratio would have been obvious based on the single mention in Cottard of organomodified silicones as optional “other agents” is unreasonable. This single mention hardly qualifies as “a reason that would have prompted” the claimed invention. *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q.2d at 1396. The “mere identification” in the prior art “of individual components of claimed limitations” is insufficient to support an obviousness rejection. *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). “Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *Id.*

More recently, the Supreme Court commented on the proper inquiry for obviousness, noting that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q.2d at 1396. As the Supreme Court points out, “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.*

The Supreme Court further recognizes,

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.

Id. at 1740-41, 82 U.S.P.Q.2d at 1396 (emphasis added) (citing *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)).

In the present case, the Office attempts to find all of the claim elements in a single prior art reference, but has merely identified individual components of the claimed limitations, which necessitated extrapolating from the very general teaching of “organomodified (such as by amine groups) silicones” in a broad list of “other agents” in Cottard to the claimed limitation of “at least one aminosilicone” and extrapolating even further to devise the claimed ratio of “the weight ratio of the at least one aminosilicone to the at least one associative polymer is greater than or equal to 1.” Here, as in *Kotzab* and as cautioned by the Supreme Court in *KSR*, the Office has fallen into the “hindsight trap” because there is “no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the] invention to make the combination in the manner claimed.” *In re Kotzab*, 217 F.3d at 1371, 55 U.S.P.Q.2d at 1318.

Further, as argued of record, Cottard does not teach or suggest all claim limitations as required by M.P.E.P. § 2143. “**All words** in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) (emphasis added). Claim 1 recites, in relevant part, that “the weight ratio of the at least one aminosilicone to the at least one associative polymer is greater than or equal to 1.” See, e.g., claim 1. This element, the

weight ratio of the at least one aminosilicone to the at least one associative polymer, is recited in all of the present independent and dependent claims, and is demonstrated in a non-limiting manner in the Example of the specification. This element is not taught or suggested by Cottard.

In *Upjohn Co. v. Mova Pharmaceutical Corp.*, 225 F.3d 1306, 56 U.S.P.Q.2d 1286 (Fed Cir. 2000), where there was prior art teaching an ingredient amount, the Federal Circuit considered and found non-obvious patent claims reciting specific amounts of components. Specifically, a patent claim reciting a composition with a range of spray-dried lactose in a range of "about not less than seventy percent (70%) by weight of the final composition" was deemed patentable over the prior art teaching of a formulation with 56.4% spray-dried lactose. 225 F.3d at 1310-11, 56 U.S.P.Q.2d at 1289-90.

Here, in contrast, there is no teaching of the claim limitation of the weight ratio of the at least one aminosilicone to the at least one associative polymer in Cottard, a fact that the Examiner has admitted. See Office Action dated Oct. 28, 2005, at 3. Indeed, Cottard merely mentions "organomodified (such as by amine groups) silicones" in a broad and general list of "other agents" which the composition of Cottard may further optionally comprise. Cottard at paragraph [0337]. It is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious" since the "mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

As Applicants pointed out in the previous response, there is no teaching in Cottard that the ratio weight ratio between aminosilicone compounds and associative polymers is a “result-effective parameter” as is required for a “routine optimization” rejection. *See* M.P.E.P. § 2144.05(II)(B) (“A particular parameter must first be recognized as a result-effective variable . . . before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.”) (citation omitted). In contrast, and contrary to the Office’s contention otherwise, the present disclosure does make it clear that the weight ratio between aminosilicone compounds and associative polymers is a result-effective parameter, as evidenced by the ratio being taught throughout the specification and claims as-filed.

Finally, the fact that Cottard teaches associative polymers is not relevant to the present claims, which recite only specific cationic associative polymers. Cottard teaches that anionic, nonionic, and cationic thickeners may be used, without any teaching that would motivate one of ordinary skill in the art to select one type of thickener over the other. In order to make a *prima facie* case of obviousness, such a suggestion or motivation “must be found in the prior art reference, not in the Applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). No such motivation or suggestion is present in Cottard.

Accordingly, for at least the reasons above, the Office has not made a *prima facie* case of obviousness with respect to claims 1-3, 43-44, and 60-102 in view of Cottard.

B. Claims 4, 8-10, 14, 15, 23, and 24 in view of Cottard and Legrand

The Office continues to reject claims 4, 8-10, 14, 15, 23, and 24 under 35 U.S.C. § 103(a) for allegedly “being unpatentable over” Cottard in view of U.S. Patent

Application Publication No. 2003/0140429 A1 to Legrand et al. ("Legrand"). Office Action at 2. Applicants respectfully disagree and continue to traverse the rejection for reasons of record and the following additional reasons.

Cottard does not teach or suggest aminosilicone polymers chosen from aminosilicones of formulae (I), (II), and (III) as claimed. The Office cites Legrand to attempt to cure this deficiency. However, as discussed above, the Office has failed to show that Cottard teaches or suggests all the limitations of the base independent claims as required under M.P.E.P. § 2143. Legrand does not cure the deficiencies of Cottard with respect to independent claim 1, and thus does not cure the deficiencies of Cottard with respect to claims 4, 8-10, 14-15, and 23-24.

As a result, the Office has not shown and cannot show that the cited references provide the requisite motivation for one of ordinary skill in the art, with no knowledge of the claimed invention, to create a composition comprising at least one oxidation dye, at least one cationic associative polymer chosen from three specific types, as claimed, and at least one aminosilicone, wherein the weight ratio of the at least one aminosilicone to the at least one associative polymer is greater than or equal to 1, as is presently claimed. *See, e.g.*, claim 1. Further, one of ordinary skill in the art would not expect such a composition to lead to the improved physiochemical stability and improved coloration selectivity of the present invention. *See* specification as-filed at page 2, paragraphs [007]-[009].

Accordingly, for at least the reasons above, the Office has not made a *prima facie* case of obviousness with respect to claims 4, 8-10, 14-15, and 23-24 in view of Cottard and Legrand.

C. Claims 45-47, 56, and 57 in view of Cottard and Laurent

The Office continues to reject claims 45-59 under 35 U.S.C. § 103(a) for allegedly “being unpatentable over” Cottard in view of U.S. Patent Application Publication No. 2002/0046431 A1 to Laurent et al. (“Laurent”). Final Office Action at 2. Applicants respectfully disagree and continue to traverse the rejection.

Cottard does not teach or suggest the claimed cationic associative polyurethane polymers. The Office cites Laurent for its teaching of cationic polyurethanes allegedly similar to the claimed cationic polyurethanes and concludes that one having ordinary skill in the art at the time the invention was made would be motivated to modify the composition of Cottard by incorporating the cationic polyurethane polymers of Laurent.

Here too, the Office has not shown and cannot show that the cited references provide the requisite motivation for one of ordinary skill in the art, with no knowledge of the claimed invention, to create a composition comprising at least one oxidation dye, at least one cationic associative polymer chosen from three specific types, as claimed, and at least one aminosilicone, wherein the weight ratio of the at least one aminosilicone to the at least one associative polymer is greater than or equal to 1, as is presently claimed. *See, e.g.*, claim 1. Further, one of ordinary skill in the art would not expect such a composition to lead to the improved physiochemical stability and improved coloration selectivity of the present invention. *See* specification as-filed at page 2, paragraphs [007]-[009].

Accordingly, for at least the reasons above, the Office has not made a *prima facie* case of obviousness with respect to claims 45-47 and 56-57 in view of Cottard and Laurent.

D. Unexpected Results Further Demonstrate that a *Prima Facie* Case of Obviousness has not been Established

To further support their position, Applicants submit herewith the Rule 1.132 Declaration of Marie-Pascale AUDOUSSET. As noted above, due to the weekend and the time difference with France, Mme. AUDOUSSET was not available to sign the Declaration in time to file with this Response. An executed Declaration will be submitted to the Office as soon as possible.

As discussed above, Cottard teaches that anionic, nonionic, and cationic thickeners may be used, without any teaching that would motivate one of ordinary skill in the art to select one type of thickener over the other. In contrast, the present claims as-amended recite a cationic associative polymer only. As shown by the experimental results contained in the AUDOUSSET Declaration, Inventive Composition A, which comprised, among other things, a cationic associative polymer as claimed, exhibited substantially superior and unexpected chromatocity properties as compared with Comparative Composition B, which was identical to Inventive Composition A except that it comprised a non-ionic associative polymer (alkyl hydroxyethyl cellulose) according to Cottard instead of the at least one cationic associative polymer as claimed. See Declaration under 37 C.F.R. § 1.132 at ¶¶ 6, 14-16. Indeed, the experimental results show that Inventive Composition A according to the claimed invention provides a chromatocity that is over 20% stronger than Comparative Composition B. *Id.* at ¶ 14. As the tests indicate, this result is directly attributed to the claimed combination, in particular the use of at least one cationic associative polymer.

In addition to all of the deficiencies of the Office's rejection discussed above, the references relied on by the Examiner do not suggest the improved chromatocity of the

claimed invention. Thus, Applicants submit that the experimental results in the unexecuted Declaration further demonstrate the improved properties of the presently claimed invention over the prior art, which does not remotely suggest such properties. *See id.* Accordingly, the Office has not established a *prima facie* case of obviousness.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, he is respectfully urged to contact Applicants' undersigned counsel at 202-408-4152.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: June 27, 2007

By: 

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Attachment: Executed Declaration under 37 C.F.R. § 1.132